

REMARKS

The Office Action mailed May 17, 2005 has been carefully reviewed along with the references cited therein. In the subject Office Action the Examiner rejected claims 1-10 under 35 U.S.C. § 102(b) as being anticipated by Salisbury et al. (U.S. Patent No. 5,435,245).

Claim 1 has been amended to recite "[a] surgical marker" instead of a marking pen. Accordingly, claim 1 no longer recites a recitation of the intended use of the claimed invention, but instead includes a structural difference between the claimed invention and Salisbury et al. Salisbury et al. fails to disclose a surgical marker and therefore fails to anticipate claim 1.

Claim 1 is also patentable over Salisbury et al. for an additional reason in that Salisbury et al. fails to disclose "a wheel comprising a polymer that absorbs ink." Salisbury et al. makes no mention of whether the wheel 16 absorbs ink. The reference simply recites that the wheel includes a printing surface; however, there is no mention that this printing surface absorbs ink. Furthermore, at Column 4, lines 35-37 Salisbury et al. states "the housing may be configured to snap seal to a cap 83, providing an air tight seal to protect the marker from drying out." The marker is shown as reference numeral 24 that includes a nib 30. Salisbury et al. never mentions that the wheel 16 could dry out, which therefore leads one to believe after considering the Salisbury et al. reference as a whole that the wheel in fact does not include a polymer that absorbs ink but rather the ink is merely maintained on the printing surface 20 prior to being deposited on a piece of paper or the like.

Claim 7 has also been amended to recite a surgical marker. Claim 7 has further been amended to include the limitation previously presented in claim 8. As mentioned above, Salisbury et al. fails to disclose a material that can absorb ink and dispense ink onto a patient's skin. Accordingly, amended claim 7 patentably defines over the cited reference.

Since this amendment is being provided after a final rejection, Applicant has attempted to limit the number of issues that have been presented to the Examiner. The proposed amendments do not raise any new issues that would require further consideration and/or search because the Examiner has already performed a search for

surgical markers. Furthermore, the amendments do not raise any new matter issues since a surgical marker was disclosed in the application as filed.

CONCLUSION

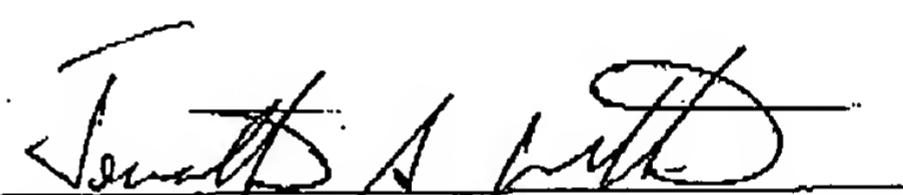
In view of the above, it is submitted that the pending claims patentably define over the cited references. Accordingly, the application is in condition for allowance. An early notice to that affect is earnestly solicited.

This response is being filed with a Notice of Appeal. Should the Examiner wish to discuss the application, he is encouraged to telephone the undersigned.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

August 16, 2005
Date

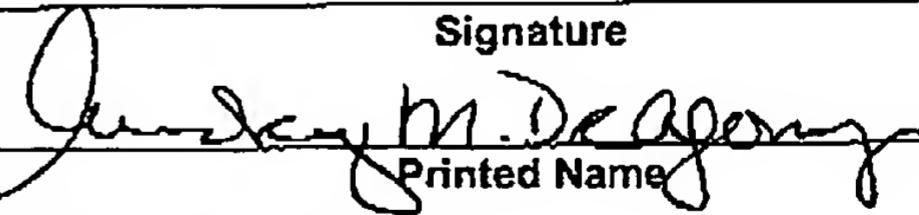


Scott A. McCollister, Reg. No. 33,691
Jonathan A. Withrow, Reg. No. 54,548
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2579
216-861-5582

CERTIFICATE OF MAILING

Under 37 C.F.R. § 1.8, I certify that this After Final Amendment is being

- deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.
- deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:	Signature
	 _____ Printed Name
Date August 16, 2005	Audrey M. Dragony